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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/670,610	09/26/2000	Denny Jaeger	4143	4665

7590 08/22/2005

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EXAMINER

NGUYEN, HAU H

ART UNIT PAPER NUMBER

2676

DATE MAILED: 08/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/670,610

Applicant(s)

JAEGER ET AL

Examiner

Hau H. Nguyen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-112 is/are pending in the application.
- 4a) Of the above claim(s) 1-47, 53 and 57-93 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 94, 95, 99, 102-104 and 108-111 is/are allowed.
- 6) ☒ Claim(s) 48-52, 54-56, 96-98, 100, 101, 105-107 and 112 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Response to Amendment

1. Applicant's arguments filed 03/23/2004 with respect to the rejection of pending claims have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground of rejection is made in view of Selig et al. (U.S. Patent No. 6,492,978) and Gibbons (U.S. Patent No. 5,973,677).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 48-52, 55-56, 97, 105, and 106 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 97, 105, and 106 claims "A device ... including: ... a plurality of said devices..." It is unclear how a device includes in itself a plurality of such same devices. Claims 48-52, which are dependent upon claim 105, and claims 55-56, which are dependent upon claim 106, are thus rejected.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 96 and 107 are rejected under 35 U.S.C. 102(e) as being anticipated by Selig et al. (U.S. Patent No. 6,492,978).

Referring to claim 96, as shown in Fig. 3, Selig et al. teach a device for providing input to a generally flat touch screen comprising a keypad 14 (base member), which includes a plurality of individual keys 24 for actuating the touch screen 16 (means for provoking touch detection), may be attached to the touch screen 16 in any suitable manner, which also allows it to be readily removed or repositioned as desired depending on the type and location of the desired virtual keypad 22. A suitable retainer 30 is configured to surround the perimeter of the keypad 14 and secure it to a suitable portion of the bezel 28 atop a portion of the touch screen 16. The retainer 30 may be formed of plastic, for example, and may snap fit into a corresponding socket formed in the bezel 28 for allowing it ready assembly and disassembly therefrom (means for securing the base member to the touch screen 16) (col. 6, lines 5-30). Thus, the keypad 14 (base member) is more adherent to the means for securing the base member (retainer 30 and bezel 28) than to the touch screen 16.

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In regard to claim 107, as cited above, Selig et al. teach a base member (keypad 14) and means for securing the base member to the touch screen 16 (retainer 30 and bezel 28), and plurality of individual keys 24 for provoking touch detection by the touch screen 16. As shown in Fig. 4, Selig et al. further teach the individual key 24 including a post 24d having a bottom surface adapted to impinge on the touch screen 16 (col. 5, lines 23-35), and the top of the post 24d having a cushion layer 24a adhered thereto (col. 4, lines 43-52).

6. Claims 98, 100, 101, and 112 are rejected under 35 U.S.C. 102(e) as being anticipated by Gibbons (U.S. Patent No. 5,973,677).

Referring to claims 98, 100, and 101, as shown in Figs. 1-3, Gibbons teaches a device for providing input to a touch screen 10, comprising: a touch screen 28, a base member (top face 26), and a securing means (cover 14) for securing the base member to the touch screen 28 (col. 3, lines 58-67). Gibbons also teach a stylus 100 associated with the base member 26 for provoking touch detection by the touch screen 28. With reference to Fig. 6, Gibbons further teaches the stylus 100, when actuated, emits radio frequency (RF) signals to the touch screen 28 (col. 5, lines 37-44), and a battery (power source 133, Fig. 6) to RF power supply the RF generator 160 (col. 6, lines 35-40). As shown in Fig. 7, Gibbons teaches the input device 10 also includes an Infrared Data Association window 48 (Fig. 1) providing a link 50 (Fig. 7) for data communication with an external device such as a printer (col. 4, lines 38-43).

In regard to claims 112, as cited above, Gibbons teaches a base member, and means for securing the base member to the touch screen, means for provoking touch detection, and also teaches an RF power supply means driven by a battery. With reference again to Fig. 6, Gibbons

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teaches a knob cap 102 having a touch switch 142 for connecting the battery 134 to the touch signal generator 160 in response to fingertip touch on the knob cap (col. 6, lines 10-26).

Allowable Subject Matter

7. Claims 94, 95, 99, 102-104, 108-111 are allowed.

Reasons for Allowable Subject Matter

8. The following is an examiner's statement of reasons for allowable subject matter:

The prior art taken singly or in combination does not teach or suggest, a device for providing input to a generally flat touch screen, among other things, comprising:

a base member including a longitudinally extending rib having a bottom surface adapted to impinge on the touch screen, a fader cap secured to the rib, a stylus tip extending from said cap toward the touch screen (claims 94, 95);

a base member comprising a post having a bottom surface adapted to impinge on the touch screen, a knob cap secured coaxially to said post and adapted for rotation about a common axis, a stylus tip extending from the knob cap toward the touch screen (claim 99);

a software means interpreting a linear touch pattern at any angle from the center point, and the rate of movement of graphics is set by the software (claim 102);

a software means interpreting a linear touch pattern at any angle from the center point, and the rate of movement of graphics is proportional to the amount of time that a touch detection is maintained at any given angle (claim 103);

a software means interpreting a touch detection displaced from the center point at an angle thereabout as a command to move a cursor at the same angle on the display (claim 104);

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a membrane extending radially from the control rod to the base member, the membrane formed of an elastic, resilient web (claim 108);

a spindle including radial teeth, and the flexible track includes a toothed surface adapted to engage the radial teeth (claim 109);

a motor means for driving the spindle to extend and retract the flexible track with respect to the peripheral edge of the touch screen (claim 110);

a fader cap including touch switch means for connecting the battery to the touch signal generator means in response to fingertip touch on the fader cap (claim 111).

The cited prior art does not teach the above mentioned features.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hau H. Nguyen whose telephone number is: 571-272-7787. The examiner can normally be reached on MON-FRI from 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Bella can be reached on 571-272-7778.

The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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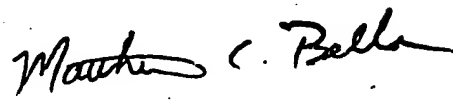
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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system contact the Electronic Business Center (EBC) at 866-2 17-9197 (toll-free).

H. Nguyen

08/08/2005



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